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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PILLAI, NAMITHA

ART UNIT PAPER NUMBER

2173

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/712,064

Applicant(s)

DAWSON-GRANADOS ET AL.

Examiner

Namitha Pillai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 31-45, 61-75 and 91-109 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 31-45, 61-75 and 91-109 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-15, 31-45, 61-75 and 91-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 2002/0052925 A1 (Kim et al.) and "HOW-TO Beat the ADS on FWP (Free Webpage Providers)?", herein referred to as the "HOW-TO" article.

Referring to claims 1, 31, 61 and 91, Kim discloses a graphical user interface with a display and a user interface selection device, which has the means for maintaining a single window interface through the web browser, as seen on the windows of Figure 2 (page 3, paragraph 45, lines 1-2 and paragraph 50, lines 1-6). Kim further discloses receiving a request to open a second browser window while a first browser window is displayed, and opening the second browser window if the request was initiated in response to a user action (page 6, paragraph 77, lines 7-9 and 16-19), wherein the user's request for another web page, through the clicking of a link is responded with the eventual display of the web page that the user had requested. Kim does not disclose ignoring the request if the request was not initiated in response to user action. The "HOW-TO" article discloses ignoring the request if the request was not initiated in response to a user action, wherein these requests would be calls for pop-up advertisements, which are requested by users and as explained by the article, it provides a means for ignoring these pop-ups ads (page 1, lines 16 and 27). It would have been obvious for one

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skilled in the art, at the time of the invention to learn from the “HOW-TO” article for implementing a means for ignoring the request for the display of advertisements, which are not initiated in response to a user action. Kim clearly discloses how pop-up advertisements are requested and displayed without any intervention from the user and the amount of annoyance this brings to users (page 1, paragraph 9). The “HOW-TO” article also discloses the annoyance that users experience and the inconvenience of these pop-up unrequested ads, and provides a solution for dealing with this problem. To relieve any inconvenience to the users, Kim would be motivated to follow the teachings of the “HOW-TO” article to implement means for ignoring the request that is not initiated by the users. Hence, one skilled in the art, at the time of the invention would have been motivated to learn from the article to implement means for ignoring the request that is not initiated by the users.

Referring to claims 2, 3, 17, 18, 32, 33, 47, 48, 62, 63, 77, 78, 92 and 93, Kim discloses opening the second browser window as a full-screen browser window if the request was initiated by a user action, this user action only possible after loading and before unloading of a page in the first browser window, in order for the user to view and click on this first browser window (page 6, paragraph 77, lines 7-9 and 16-19), and as seen in Figure 2, the reference number 204, is the second browser window shown in full-screen that is displayed in response to the user action, from the first screen, reference number 200, wherein the first browser window would be superimposed or replaced with the second browser window as seen in reference number 204 of Figure 2.

Referring to claims 4, 19, 34, 49, 64, 79 and 94, Kim discloses opening a second browser window between pages of the first and second browser windows, at which time a load finished

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event for the first browser window is finished but before receiving an unload event for the first browser window, thus discussing the events that occur “between pages” (page 1, paragraph 9, lines 1-4).

Referring to claims 5, 20, 35, 50, 65, 80 and 95, Kim discloses that the opening of the second browser window based on the second web-page that the user is accessing, is distinct from the first browser window containing the first browser page, from where the user has clicked on a link (page 6, paragraph 77, lines 6-10 and 16-19), as also is seen in Figure 2, wherein the displayed of two different instances of the web browser is shown in relation to different time slots, thus showing two different instances.

Referring to claims 6 and 96, Kim discloses the unloading of one first browser instance, as disclosed in the “transition” from one page to another, to the loading of a second browser instance, wherein modifications of two both the browser window instances will occur as a result of these unloading and loading events (page 3, paragraph 44, lines 7-8).

Referring to claims 7, 22, 37, 52, 67, 82 and 97, Kim discloses as seen in Figure 12, a first browser window containing a plurality of frames, represented as the “Ecatalog” and “Links” frames, wherein the request to open a second browser window, based on the user’s clicking of one of the links in these frames, represented as the “boxed” link, wherein the request is associated with one of the plurality of frames as seen, and wherein the method further comprises opening the second browser window after loading the frame associated with the request to open the second browser window, as is seen in the transition of Figure 14 to Figure 15, wherein the second browser window displayed the “advertising at the speed of life” is associated with the “ADNETWARE” which is shown to be chosen by the user, and as seen in Figure 14, the frame

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has been loaded, allowing the user to choose their request which can then only be shown in the second browser window.

Referring to claims 8, 23, 38, 53, 68, 83 and 98, as shown in the plurality of frames in Figure 14, the frames must be loaded then only displayed as seen in Figure 14, in order for a request to be made from these frames, and an associated second browser window to be displayed, associated with a request made from the frames, as seen in Figure 15.

Referring to claims 9, 24, 39, 54, 69, 84 and 99, Kim discloses means wherein a dialog box represented as the click-on advertisement is stored locally and suppressed until a web page that is associated with the request to open the dialog box is displayed, wherein the advertisement is suppressed until a web page that is associated with the advertisement as been displayed, wherein then the dialog box is called on (page 6, paragraph 77, lines 8-14).

Referring to claims 10, 25, 40, 55, 70, 85 and 100, Kim and the "HOW-TO" article discloses that amongst the information displayed with the browser window, includes multi-media data and new broadcasts, both of which include sounds (page 3, paragraph 44, lines 13-15), hence when these pop-up advertisements are ignored, as stated in previous claims, the sounds associated with these displays would also be ignored or suppressed. It would have been obvious for one skilled in the art, at the time of the invention to suppress the generation of a sound associated with a browser window that is not displayed. Kim and the "HOW-TO" article established a system, wherein uninitiated requests by the user, such as pop-up advertisements would be ignored, wherein all information associated with these ads/commercials would be ignored and hence, the sounds associated with these ads would be suppressed. Hence, it would

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have been obvious for one skilled in the art, at the time of the invention to suppress the sounds associated with a browser window that is not displayed.

Referring to claims 11, 26, 41, 56, 71, 86 and 101, Kim discloses receiving a request to close a browser window, closing the browser window if another browser window is open and ignoring the request if no other browser window is open (page 6, paragraph 77, line 16-19), wherein the AD window closes when the user requested window has been opened, but remains open when user initiated window has not yet been opened.

Referring to claims 12, 27, 42, 57, 72, 87 and 102, Kim discloses maintaining a browser history, wherein a history of transitions between the first and second browser windows are maintained (page 3, paragraph 49, lines 8-11).

Referring to claims 13, 28, 43, 58, 73, 88 and 103, Kim discloses means for maintaining a browser history through storing of the history of the displayed browser windows (page 3, lines paragraph 49, 9-11).

Referring to claims 14, 29, 44, 59, 74, 89 and 104, Kim discloses means for building the browser history from all kinds of user and internet activities, thus including the history of a set of simultaneously open browser windows as seen Figures 12-16 (page 3, paragraph 49, lines 4-9).

Referring to claims 15, 30, 45, 60, 75, 90 and 105, Kim discloses detecting through browser history a transition between two simultaneously open browser windows and in response to the detected transition, hiding one of the first and second browser windows and displaying a different one of the first and second browser windows (page 8, paragraphs 110-112).

Referring to claims 16, 46, 76 and 106, Kim discloses a graphical user interface with a display and a user interface selection device, which has the means for maintaining a single

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window interface through the web browser, as seen on the windows of Figure 2 (page 3, paragraph 45, lines 1-2 and paragraph 50, lines 1-6). Kim further discloses receiving a request to open a second browser window while a first browser window is displayed, and opening the second browser window if the request was initiated in response to a user action (page 6, paragraph 77, lines 7-9 and 16-19), wherein the user's request for another web page, through the clicking of a link is responded with the eventual display of the web page that the user had requested. Kim discloses the concept of determination of unrequested information from the user wherein, this information would be automatically requested during the transition from one page to another page, wherein then it is determined that the user did not request the information, since the request was initiated in "between pages", when either the loading or unloading of a page in the first browser window is occurring (page 1, paragraph 9, lines 1-4 and page 3, paragraph 44, lines 7-8). Kim also discloses that the request was in response to a user action, where the clicking of the link on the first browser window and the determination of this user request is based on the clicking of a link which is currently displayed to the user on a first browser window, which determines that the request must be initiated after loading and before unloading of a page in the first browser window, in order for the user to view and click on this first browser window (page 6, paragraph 77, lines 8-10). Kim does not disclose ignoring the request if the request was not initiated in response to user action. The "HOW-TO" article discloses ignoring the request if the request was not initiated in response to a user action, wherein these requests would be calls for pop-up advertisements, which are requested by users and as explained by the article, it provides a means for ignoring these pop-ups ads (page 1, lines 16 and 27). It would have been obvious for one skilled in the art, at the time of the invention to learn from the "HOW-

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TO” article for implementing a means for ignoring the request for the display of advertisements, which are not initiated in response to a user action. Kim clearly discloses how pop-up advertisements are requested and displayed without any intervention from the user and the amount of annoyance this brings to users (page 1, paragraph 9). The “HOW-TO” article also discloses the annoyance that users experience and the inconvenience of these pop-up unrequested ads, and provides a solution for dealing with this problem. To relieve any inconvenience to the users, Kim would be motivated to follow the teachings of the “HOW-TO” article to implement means for ignoring the request that is not initiated by the users. Hence, one skilled in the art, at the time of the invention would have been motivated to learn from the article to implement means for ignoring the request that is not initiated by the users.

Referring to claims 21, 36, 51, 66 and 81, Kim discloses the communication of the two browser windows, wherein the first and second browser windows must communicate such that, once the user has clicked on a request on the first page to access a second page, communication has occurred between the pages, thereby forming a link in response to events occurring in the first browser window and second browser instances (page 6, paragraph 77, lines 8-10 and 17-20).

Referring to claims 106, Kim and the “HOW-TO” article discloses basing a determination that the request was not in responses to user action on information that the request was initiated during either loading or unloading of a page in the first browser window, wherein a determination is made for if pop-up ads are disclosed, wherein these pop-up ads are requested during loading and unloading of web pages (“HOW-TO”, page 3, lines 9-18). Kim and the “HOW-TO” article also discloses basing a determination that the request was in response to user action on information that the request was initiated after loading and before unloading of a page

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in the first browser window, wherein the check for pop up ads, and the result of this check determine whether the request is a pop-up ad, which is a request that is not user initiated or a request initiated by a user which would not be a pop-up ad ("HOW-TO", page 3, lines 9-18).

Response to Arguments

2. Applicant's arguments filed 1/26/04 have been fully considered but they are not persuasive.

With respect to Applicant's arguments that the "HOW-To" document does not disclose ignoring the request if the request was not initiated in response to a user action". This article primarily discloses a method for preventing the display of pop-up ads, wherein it is commonly known that these pop-up ads are displayed without any user interaction and wherein a method is taught for ignoring these pop-up ads that are not desired by the user. As is also clearly disclosed with the code example under "Killing pop-ups when they appear" (Section 1.2, page 3), these pop-up ads are clearly not opened by user but is done with a method that is hard coded and wherein this section teaches a step to automatically close and thereby ignore these windows that are opened without user action to open these windows.

With respect to Applicant's arguments that Kim teaches away from the idea of ignoring a second window not initiated by user response. Kim's main teachings is the idea of displaying ads in a full screen window but nonetheless, Kim still addresses the needs of the users, and the problems that pop-up ads such as those mentioned in the "HOW-To" document cause (page 1, paragraph 9). Hence, Kim has provided a motivation for learning from the "HOW-To" document, wherein in addition to the invention claimed, Kim's motivation to meet the needs of

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the user with “little or no annoyance to the user” (page 2, paragraph 26) would motivate Kim to learn from the “HOW-To” document.

With respect to Applicant’s arguments that Kim and the “HOW-To” document have different approaches. As per the claims in the present invention, a simple method for ignoring requests to open a second window that was not initiated by user interaction, wherein there has been no disclosure to the approaches takes for carrying out this method including any discussion of modifications to the client and the website. Furthermore, the two approaches mentioned, wherein a combination of modifications on a web-surfing client and the modification of a website itself does not teach that the references teach away from each other. Furthermore, regardless if Kim’s invention is mainly functional in the client browser system, it is the server that would nonetheless have to provide the information that is needed for this client to function as stated by Kim, and wherein the code from the server can thus include additional methods provided and taught in “HOW-To” which can be sent to Kim’s client to properly carry out the steps for preventing the display of unnecessary ads. Furthermore, Applicant has relied on extensive methods that have not been disclosed in the present claims. Applicant had made arguments that “HOW-To” does not disclose adaptations for a browser configured to move from website to website hosted by different servers” and that it is unclear if the combination of Kim and “HOW-To” would mean the invention would primarily operate on a server or client. The disclosed claims do not address any approaches that are taken that would clearly set forth the irrelevance of this combination and does not disclose any information concerning the role of clients and servers in carrying out the operations disclosed currently in the claims.

With respect to Applicant's arguments that there is no disclosure of a determining if a request was made in response to a user action. The "HOW-To" document teaches a determining step for determining if the request is a pop-up ad wherein this determining step inherently checks if the request is otherwise user initiated, wherein if the request is not a pop-up ad, it is a user initiated request (page 3, lines 9-18).

With respect to Applicant's arguments that "HOW-To" does not actually ignore requests for second windows. "HOW-To" by immediately closing the requested window allows for the user to ignore the windows without any user interaction, as shown in the code on page 3 (Section 1.2).

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

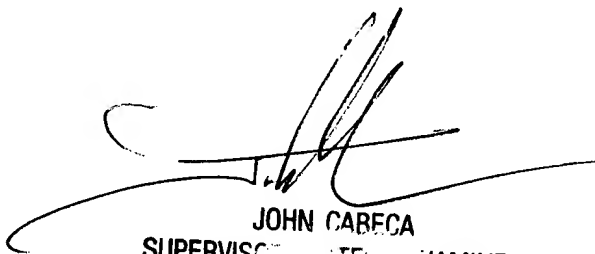
Responses to this action should be mailed to: Commissioner of Patents and Trademarks,

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Washington D.C. 20231. If applicant desires to fax a response, central FAX number (703) 872-9306 may be used. NOTE: A Request for Continuation (Rule 60 or 62) cannot be faxed. Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document. Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namitha Pillai whose telephone number is (703) 305-7691. The examiner can normally be reached on 8:30 AM - 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Namitha Pillai
Assistant Examiner
Art Unit 2173
March 29, 2004



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